



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/087,871	06/02/1998	GERALD WAGNER	0708-4038	1082

7590 12/24/2003

MORGAN & FINNEGAN  
345 PARK AVENUE  
NEW YORK, NY 10154

EXAMINER

GABEL, GAILENE

ART UNIT	PAPER NUMBER
----------	--------------

1641

DATE MAILED: 12/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n No.

09/087,871

Applicant(s)

WAGNER, GERALD

Examin r

Gailene R. Gabel

Art Unit

1641

-- The MAILING DATE f this c mmunication appears n the cover sh et with the correspondence address --

## Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Applicant's Response***

1. Applicant's response filed 10/10/03 in Paper No. 21 is acknowledged. Currently, claims 1-21 are pending. Claims 1-12 are under examination.

### ***Rejections Withdrawn***

2. In light of Applicant's amendment and argument, the rejection of claims 1-12 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, is hereby, withdrawn.
3. In light of Applicant's amendment and argument, the rejection of claims 1-12 under 35 U.S.C. 112, first paragraph, as containing new subject matter, is hereby, withdrawn.
4. In light of Applicant's amendment and argument, the rejection of claims 1-12 under 35 U.S.C. 112, first paragraph, as lacking enablement, is hereby, withdrawn.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1641

5. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lillig et al. (US 4,965,049) in view of Cantantore et al. (US 5,772,963) and in further view of Aziz et al. (Journal of Cellular Biochemistry, Supp. 17G, pp. 247 (1993)) for reason of record.

### **New Grounds of Rejection**

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-12 are rejected under the judicially created doctrine of double patenting over claims 23-30 and 37-38 of U. S. Patent No. 6,099,469 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a diagnostic system comprising an immunoassay

Art Unit: 1641

analyzer and a clinical chemistry analyzer, having a software program capable of performing biological measurements sets according to reflexive algorithm.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

7. Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 23-30 and 37-38 of U.S. Patent No. 6,099,469 in view of Lillig et al. (US 4,965,049).

US Patent Number 6,099,469 (ARMSTRONG et al.) discloses a diagnostic system comprising an immunoassay analyzer, a clinical chemistry analyzer, and a processor, having a software program capable of performing biological measurements sets according to reflexive algorithm.

Armstrong et al. differs from the instant invention in failing to disclose an automated sample handling device coupled between the analyzers.

Lillig discloses a clinical chemistry analyzer system combining analyzers, each adapted for independent operation and each possessing different operational characteristics for different applications wherein each modular analyzer is adapted to operate as a portion of a system of modular analyzers (see column 2, lines and 8-26 and Figure 3). The system includes a first analyzer and a second analyzer each including a sample carousel, analyzing means, and an automated sample handling

Art Unit: 1641

device (automated probe means) for transferring samples between the sampling carousels and the analyzing means. A processor is in communication with the analyzers wherein electronic and electrical interfaces form public and/or private networks between the analyzers so as to form the system. Operational information and instructions are coded into the analyzers through a disk drive (see column 6, lines 51-65).

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to incorporate an automated handling device as taught by Lillig between the analyzers in the system taught by Armstrong et al. to thus, allow sharing fluid transfer therebetween, because it allows for the system to operate as a single system having the advantage of increased capacity and versatility.

### ***Response to Arguments***

8. Applicant's arguments filed 10/10/03 have been fully considered but they are not persuasive.

A) Applicant argues that Cantantore et al. does not qualify as prior art under 35 §USC 103 (a)/(c) since Cantantore qualifies only as prior art under 35 §USC 102(e) but since Cantantore and the instant invention are commonly owned by Bayer, Cantatore is disqualified as prior art for purposes of asserting a 35 §USC 103(a) rejection.

In response, Applicant's argument is not persuasive because Applicant lacks the required evidentiary statement to disqualify Cantantore as a prior art reference, that "the

Art Unit: 1641

application and the Cantantore et al. were, at the time the invention was made, owned by, or subjected to an obligation of assignment to, the same person”.

9. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gailene R. Gabel whose telephone number is (703) 305-0807. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30 AM to 2:30 PM.

Art Unit: 1641

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (703) 305-3399. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0169.

Gailene R. Gabel  
Patent Examiner  
Art Unit 1641  
December 15, 2003

*Christopher L. Chin*  
CHRISTOPHER L. CHIN  
PRIMARY EXAMINER  
GROUP ~~1800~~ 1641